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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/700,215	SEVIER, RICHARD G.
	Examiner	Art Unit
	William C. Storey	2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 November 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-50 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-50 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application
6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1, 2, 3, 5, 6, 7, 8, 11, 12, 14, 15, 16, 17, 20, 21, 22, 24, 25, 26, 27, 30, 31, 33, 34, 35, 36, 39, 40, 41, 42, 43, 45, 47, 48, & 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Okubo (US Patent Application Publication 2005/0200903).

Regarding claim 1, Okubo discloses a digital image selection method, comprising: obtaining a first digital image of a first side of a physical object; obtaining a second digital image of a second side of the physical object; examining the first digital image to determine if it is substantially blank; sending the second digital image for processing if the first digital image is substantially blank; and sending the first digital image for processing if the first digital image is not substantially blank. In addition, Okubo discloses an image-processing device. Further, Okubo discloses that an “image-processing unit 12 converts the analog RGB read signals received from the image reading unit 11 into digital image data of continuous-tone or multi-value (multi-

valued image data), for example color image data (or gray image data). The image-processing unit 12 sends the multi-valued image data to the binarizing unit 13 and the optimizing unit 15," as disclosed at paragraph 23. This reads on claimed "obtaining a first digital image of a first side of a physical object" and claimed obtaining a second digital image of a second side of the physical object." In addition, Okubo discloses the "optimizing unit 15 eliminates pages judged as blank pages from the image data received directly from the image processing unit 12, on the basis of the determination for each page of the image data received from the determining unit 14," as disclosed at Figure 1 and paragraph 35. This reads on claimed "examining the first digital image to determine if it is substantially blank." Further, Okubo discloses "the optimizing unit 15 optimizes the image data and sends the optimized image data to the compressing unit 16 and data output unit," as disclosed at Figure 1 and paragraph 35. This and the previous disclosures read on "sending the second digital image for processing if the first digital image is substantially blank; and sending the first digital image for processing if the first digital image is not substantially blank."

Regarding claim 2, claim 2 is rejected under the reasoning as applied for claim 1. In addition, Okubo discloses "the determining unit 14 determines on a page-by-page basis whether or not data is image data," which reads on claimed if the "if the digital image of the first set is not substantially blank" and "if the first digital image is substantially blank," as disclosed in paragraph 27. If the "set" is a set of 1, then the method is the same for as for claim 1. For example, a piece of paper subject to the method of claim 1 would run the course of claim 2's method in the same way. If the

front side of the paper (set) is blank, the opposite side of the set of 1 is sent. If the front side isn't blank, the front side of the set of 1 will be sent.

Regarding claim 3, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses examining the second digital image to determine if it is substantially blank and sending the second digital image for processing if the second digital image is not substantially blank. Further, Okubo discloses "the determining unit 14 determines on a page-by-page basis whether or not data is image data," which reads on claimed "examining the second image to determine if it is substantially blank," as disclosed in paragraph 27. Okubo discloses sending the "result of the determination to the optimizing unit 15," "the optimizing unit 15 eliminates pages which were judged as blank pages by the determining unit 14," and then the optimizing unit sends the non-blank pages down the channels to the data output unit for sending out, which reads on claimed "sending the second digital image for processing if the second digital image is not substantially blank," as disclosed in paragraphs 27, 28, and 35.

Regarding claim 5, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses discarding the first digital image if it is substantially blank. Further, Okubo discloses the optimizing unit 15 eliminates pages which were judged as blank pages by the determining unit 14 from the image data received directly from the image processing unit 12, which reads on claimed the method of claim 1, further comprising discarding the first digital image if it is substantially blank, as disclosed at paragraph 28.

Regarding claim 6, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses wherein the steps of obtaining the first and second digital images comprise: scanning the first side of the physical object to generate the first digital image; and scanning the second side of the physical object to generate the second digital image. Okubo discloses in paragraph 22 an image reading unit 11 comprising a well-known CCD or the like, which optically reads an image from a double-sided or single-sided original. “Optically reads” reads on claimed scanning. Sides of a double-sided original read on first side of the physical object and second side of the physical object. In addition, Okubo discloses an “image-processing unit 12 converts the analog RGB read signals received from the image reading unit 11 into digital image data of continuous-tone or multi-value (multi-valued image data)” disclosed at paragraph 23. Digital image data reads on claimed digital image.

Regarding claim 7, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses sending the second digital image for processing comprises sending the second digital image to be printed if the first digital image is substantially blank; and sending the first digital image for processing comprises sending the first digital image to be printed if the first digital image is not substantially blank. Specifically, Okubo discloses that the data output unit 17 may send the image data to an external device such as a printer, which, in combination with the disclosure referenced in support of the rejection of claim 1, reads on claimed the method of claim 1, wherein: sending the second digital image for processing comprises sending the second digital image to be printed if the first digital image is substantially blank; and sending the first digital image

for processing comprises sending the first digital image to be printed if the first digital image is not substantially blank, as disclosed at paragraph 30. Disclosed printer reads on claimed “printed.”

Regarding claim 8, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses sending the second digital image for processing comprises sending the second digital image to be incorporated in a facsimile transmission if the first digital image is substantially blank; and sending the first digital image for processing comprises sending the first digital image to be incorporated in a facsimile transmission if the first digital image is not substantially blank. Specifically, Okubo discloses that the data output unit 17 may send the image data to an external device such as a facsimile, which, in combination with the disclosure referenced in support of the rejection of claim 1, reads on claimed the method of claim 1, wherein: sending the second digital image for processing comprises sending the second digital image to be incorporated in a facsimile transmission if the first digital image is substantially blank; and sending the first digital image for processing comprises sending the first digital image to be incorporated in a facsimile transmission if the first digital image is not substantially blank, as disclosed at paragraph 30. Disclosed facsimile reads on claimed incorporated in a facsimile transmission.

Regarding claim 11, claim 11 is rejected under the reasoning as applied for claim 1. Claim 11 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 12, claim 12 is rejected under the reasoning as applied for claim 3. Claim 12 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 14, claim 14 is rejected under the same reasoning as applied for claim 5. Claim 14 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 15, claim 15 is rejected under the same reasoning as applied for claim 6. Claim 15 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 16, claim 16 is rejected under the same reasoning as applied for claim 7. Claim 16 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 17, claim 17 is rejected under the same reasoning as applied for claim 8. Claim 17 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 20, Okubo discloses everything claimed as applied above (see claim 1). In addition, claim 20 discloses a computer readable medium having instructions for: obtaining a first set of ordered digital images, each digital image of the first set being a digital image of a first side of a physical object, the physical object being one of an ordered set of physical objects; obtaining a second set of ordered digital images, each digital image of the second set being a digital image of a second side of a physical object, the physical object being one of the ordered set of physical objects;

examining the first set of digital images to determine if the first set is substantially blank; sending the second set of digital images for processing if the first set of digital images is substantially blank; and sending the first set of digital images for processing if the first set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 1, thus claim 20 is rejected for the same reasons as stated above in the rejection of claim 1.

Regarding claim 21, claim 21 is rejected under the same reasoning as applied for claim 20 and claim 2.

Regarding claim 22, Okubo discloses everything claimed as applied above (see claim 3). In addition, claim 22 discloses the medium of claim 20, having further instructions for examining the second digital image to determine if it is substantially blank and sending the second digital image for processing if the second digital image is not substantially blank. However, this is not patently distinct from the method described in claim 3, thus claim 22 is rejected for the same reasons as stated above in the rejection of claim 3.

Regarding claim 24, Okubo discloses everything claimed as applied above (see claim 5). In addition, claim 24 discloses the medium of claim 20, having further instructions for discarding the first digital image if it is substantially blank. However, this is not patently distinct from the method described in claim 5, thus claim 24 is rejected for the same reasons as stated above in the rejection of claim 5.

Regarding claim 25, Okubo discloses everything claimed as applied above (see claim 6). In addition, claim 25 discloses the medium of claim 20, wherein the

instructions for obtaining the first and second digital images include instructions for: scanning the first side of the physical object to generate the first digital image; and scanning the second side of the digital object to generate the second digital image. However, this is not patently distinct from the method described in claim 6, thus claim 25 is rejected for the same reasons as stated above in the rejection of claim 6.

Regarding claim 26, Okubo discloses everything claimed as applied above (see claim 7). In addition, claim 26 discloses the medium of claim 20, wherein the instructions for: sending the second digital image for processing include instructions for sending the second digital image to be printed if the first digital image is substantially blank; and sending the first digital image for processing include instructions for sending the first digital image to be printed if the first digital image is not substantially blank. However, this is not patently distinct from the method described in claim 7, thus claim 26 is rejected for the same reasons as stated above in the rejection of claim 7.

Regarding claim 27, Okubo discloses everything claimed as applied above (see claim 8). In addition, claim 27 discloses the medium of claim 20, wherein the instructions for: sending the second digital image for processing include instructions for sending the second digital image to be incorporated in a facsimile transmission if the first digital image is substantially blank; and sending the first digital image for processing include instructions for sending the first digital image to be incorporated in a facsimile transmission if the first digital image is not substantially blank. However, this is not patently distinct from the method described in claim 8, thus claim 27 is rejected for the same reasons as stated above in the rejection of claim 8.

Regarding claim 30, Okubo discloses everything claimed as applied above (see claim 11). In addition, claim 30 discloses a computer readable medium having instructions for: obtaining a first set of ordered digital images, each digital image of the first set being a digital image of a first side of a physical object, the physical object being one of an ordered set of physical objects; obtaining a second set of ordered digital images, each digital image of the second set being a digital image of a second side of a physical object, the physical object being one of the ordered set of physical objects; examining the first set of digital images to determine if the first set is substantially blank; sending the second set of digital images for processing if the first set of digital images is substantially blank; and sending the first set of digital images for processing if the first set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 11, thus claim 30 is rejected for the same reasons as stated above in the rejection of claim 11.

Regarding claim 31, Okubo discloses everything claimed as applied above (see claim 12). In addition, claim 31 discloses the medium of claim 30, having further instructions for examining the second set of digital images to determine if the second set is substantially blank and sending the second set of digital images for processing if the second set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 12, thus claim 31 is rejected for the same reasons as stated above in the rejection of claim 12.

Regarding claim 33, Okubo discloses everything claimed as applied above (see claim 14). In addition, claim 33 discloses the medium of claim 30, having further

instructions for discarding the first set of digital images if it is substantially blank.

However, this is not patentably distinct from the method described in claim 14, thus claim 33 is rejected for the same reasons as stated above in the rejection of claim 14.

Regarding claim 34, Okubo discloses everything claimed as applied above (see claim 15). In addition, claim 34 discloses the medium of claim 30, having further instructions for first and second sets of digital images include instructions for: scanning the first side of each physical object to generate the first set of digital images; and scanning the second side of each physical object to generate the second set of digital images. However, this is not patentably distinct from the method described in claim 15, thus claim 34 is rejected for the same reasons as stated above in the rejection of claim 15.

Regarding claim 35, Okubo discloses everything claimed as applied above (see claim 16). In addition, claim 35 discloses the medium of claim 30, wherein the instructions for sending the second set of digital images for processing include instructions for sending the second set of digital images to be printed if the first set of digital images is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be printed if the first set of digital images is not substantially blank. However, this is not patentably distinct from the method described in claim 16, thus claim 35 is rejected for the same reasons as stated above in the rejection of claim 16.

Regarding claim 36, Okubo discloses everything claimed as applied above (see claim 17). In addition, claim 36 discloses the medium of claim 30, wherein the

instructions for sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in a facsimile transmission if the first set of digital images is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in a facsimile transmission if the first set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 17, thus claim 36 is rejected for the same reasons as stated above in the rejection of claim 17.

Regarding claim 39, Okubo discloses everything claimed as applied above (see claim 1). In addition, claim 39 discloses a system for digital image selection, comprising: an image manager operable to obtain a first digital image of a first side of a physical object and a second digital image of a second side of the physical object; a content module operable to examine the first digital image to determine if it is substantially blank; and wherein the image manager is further operable to send the second digital image for processing if the first digital image is substantially blank and to send the first digital image for processing if the first digital image is not substantially blank. However, the system simply provides structure for the method of claim 1 and is not patently distinct, thus, claim 39 is rejected for the same reasons as stated above in the rejection of claim 1. Specifically, Okubo discloses an image reading unit, image processing unit, binarizing unit, determining unit, optimizing unit, and compressing unit, and data output unit which read on claimed image manager, as disclosed in figure 1.

Further, Okubo discloses a determining unit and an optimizing unit, which read on claimed content module, as disclosed in figure 1.

Regarding claim 40, claim 40 is rejected under the same reasoning as applied for claim 39. Claim 40 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 41, Okubo discloses everything claimed as applied above (see claim 3). In addition, claim 41 discloses the system of claim 39, wherein the content module is further operable to examine the second digital image to determine if it is substantially blank and the image manager is further operable to send the second digital image for processing if the second digital image is not substantially blank. However, the system simply provides structure for the method of claim 3 and is not patently distinct, thus, claim 41 is rejected for the same reasons as stated above in the rejection of claim 3.

Regarding claim 42, claim 42 is rejected under the same reasoning as applied for claim 39. Claim 42 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 43, Okubo discloses everything as applied above for claim 42. In addition, claim 43 is rejected under similar reasoning as applied for claim 3. Claim 43 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 45, Okubo discloses everything claimed as applied above (see claim 1). In addition, claim 45 discloses a digital image production system, comprising a scan engine operable to generate a first digital image of a first side of a physical object

and a second digital image of a second side of the physical object; a production engine operable to process the first and the second digital images; digital image selector operable to: examine the first digital image to determine if it is substantially blank; send the second digital image to the production engine if the first digital image is substantially blank; and send the first digital image to the production engine if the first digital image is not substantially blank. However, the system simply provides structure for the method of claim 1 and is not patentably distinct, thus, claim 45 is rejected for the same reasons as stated above in the rejection of claim 1. Specifically, Okubo discloses an image reading unit, an image processing unit, and a binarizing unit, which reads on claimed scan engine, as disclosed in Figure 1. Further, Okubo discloses an external device to which data output unit 17 sends image data, which reads on claimed production engine, as disclosed in paragraph 30. Okubo discloses a determining unit, optimizing unit, compressing unit, and data output unit, which read on claimed digital image selector, as disclosed in Figure 1.

Regarding claim 47, Okubo discloses everything claimed as applied above (see claim 7). In addition, claim 47 discloses the system of claim 45, wherein the production engine is a print engine. However, the system simply provides structure for the method of claim 7 and is not patentably distinct, thus, claim 47 is rejected for the same reasons as stated above in the rejection of claim 7. Specifically, Okubo discloses an actualization of the external device as a printer, which reads on claimed wherein the production engine is a print engine, as disclosed in paragraph 30.

Regarding claim 48, Okubo discloses everything claimed as applied above (see claim 8). In addition, claim 48 discloses the system of claim 45, wherein the production engine is a facsimile engine. However, the system simply provides structure for the method of claim 8 and is not patentably distinct, thus, claim 48 is rejected for the same reasons as stated above in the rejection of claim 8. Specifically, Okubo discloses an actualization of the external device as a facsimile, which reads on claimed wherein the production engine is a facsimile engine, as disclosed in paragraph 30.

Regarding claim 50, Okubo discloses everything as applied for claim 1. Image reading unit 11, image processing unit 12, and binarizing unit 12 are equivalent to means for obtaining a first digital image of a first side of a physical object and a second digital image of a second side of the physical object. The image-reading unit obtains the image of the sides of a physical object, as disclosed in paragraph 22. The image processing unit and binarizing unit read on converting the obtained data into a digital image, as disclosed at paragraph 23 and 24. Determining unit 14 is equivalent to means for examining the first digital image to determine if it is substantially blank, as disclosed at paragraph 27. Data output unit 17 is equivalent to means for sending the second digital image for processing if the first digital image is substantially blank and means for sending the first digital image for processing if the first digital image is not substantially blank, as disclosed in paragraph 30. The external device disclosed in paragraph 30 is a means for processing.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo in view of Furumura (Japanese Publication 05-048835).

Regarding claim 4, Okubo discloses everything claimed as applied above in claim 1. However, Okubo fails to disclose wherein the step of examining is performed before the step of obtaining the second digital image and the step of obtaining the second digital image is performed only if the first digital image is substantially blank. In addition, the examiner maintains that it was well known in the art to provide the step of examining is performed before the step of obtaining the second digital image and the step of obtaining the second digital image is performed only if the first digital image is substantially blank, as taught by Furumura.

In a similar field of endeavor, Furumura discloses the step of examining is performed before the step of obtaining the second digital image and the step of obtaining the second digital image is performed only if the first digital image is substantially blank. In addition, Furumura discloses an image reader. Further, Furumura describes scanning one side of a piece of paper; checking whether or not it

was blank after it has been scanned; if it is, the end of the paper is pinched and sent back through to scan the other side, as disclosed in paragraph 12.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing the step of examining before the step of obtaining the second digital image and the step of obtaining the second digital image performed only if the first digital image is substantially blank, as taught by Furumura, for the purpose of preventing blank paper information from being read by erroneous insertion of the paper surface into the input of the image reading device, as disclosed in the abstract.

Regarding claim 23, Okubo discloses everything claimed as applied above (see claim 4). In addition, claim 23 discloses the medium of claim 20, wherein the instructions obtaining the second digital image include instructions for obtaining the second digital image only if the first digital image is substantially blank. However, this is not patentably distinct from the method described in claim 4, thus claim 23 is rejected for the same reasons as stated above in the rejection of claim 4.

5. Claims 9, 18, 28, 37, 46, & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo in view of Garcia (US Publication Application Publication 2003/0048470).

Regarding claim 9, Okubo discloses everything claimed as applied above in claim 1. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30. However, Okubo fails to describe incorporation of the image file on the computer into an

electronic mail message. In addition, the examiner maintains that it was well known in the art to provide incorporation of an image file into an electronic mail message, as taught by Garcia.

In a similar field of endeavor, Garcia discloses incorporating an image file into an electronic mail message. In addition, Garcia discloses a web browser for network printer. Further, Garcia describes scanning documents to create a digital image of a document and an email function that permits electronic mailing of the digital image, as disclosed in paragraph 29.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing incorporation of an image file into an electronic mail message, as taught by Garcia, for the purpose of acting as an another method of data output, as is well known in the art.

Regarding claim 18, claim 18 is rejected under the same reasoning as applied for claim 9. Claim 18 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 28, Okubo discloses everything claimed as applied above (see claim 9). In addition, claim 28 discloses the medium of claim 20, wherein the instructions for: sending the second digital image for processing include instructions for sending the second digital image to be incorporated in an electronic mail message if the first digital image is substantially blank; and sending the first digital image for processing include instructions for sending the first digital image to be incorporated in an electronic mail message if the first digital image is not substantially blank. However, this is not

patently distinct from the method described in claim 9, thus claim 28 is rejected for the same reasons as stated above in the rejection of claim 9.

Regarding claim 37, Okubo discloses everything claimed as applied above (see claim 18). In addition, claim 37 discloses the medium of claim 30, wherein the instructions for sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in an electronic mail message if the first set of digital images is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in an electronic mail message if the first set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 18, thus claim 37 is rejected for the same reasons as stated above in the rejection of claim 18.

Regarding claim 46, Okubo discloses everything claimed as applied above (see claim 9). In addition, claim 46 discloses the system of claim 45, wherein the production engine is an electronic mail engine. However, the system simply provides structure for the method of claim 9 and is not patently distinct, thus, claim 46 is rejected for the same reasons as stated above in the rejection of claim 9. Specifically, Okubo discloses an external device that may be sent to a computer and from there, emailed. This and the cited claim disclosures read on claimed production engine as an electronic mail engine, as disclosed in paragraph 30. Okubo's disclosure of an external device in paragraph 30 is actualized as an electronic email engine and production engine.

Regarding claim 49, Okubo discloses everything claimed as applied above in claim 45. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, printer, or facsimile as disclosed in paragraph 30. Further, Okubo discloses that the image data reader 18 and the image data processor 19 (which performs the method of claim 1) are contained within a scanner, which reads on claimed scan engine and digital image selector integrated into a single peripheral device, as disclosed in paragraph 21. However, Okubo fails to describe wherein the scan engine, the production engine, and the digital image selector are all integral parts of a single peripheral device. In addition, the examiner maintains that it was well known in the art to provide a scan engine, a production engine, and a digital image selector integrated into a single peripheral device, as taught by Garcia.

In a similar field of endeavor, Garcia discloses incorporating a scan engine, a production engine, and a digital image selector integrated into a single peripheral device. In addition, Garcia discloses a web browser for network printer. Further, Garcia discloses a printer 12 that may include a scanning mechanism, printing mechanism, email mechanism, and more, as disclosed in paragraph 26.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing incorporation of the scanner in paragraph 21 into the printer 12, as taught by Garcia, for the purpose of the subcomponents inside the printer 12 acting as “external devices” for the output unit 17 of the image data processor 19, as disclosed in Okubo paragraph 30 and 21.

6. Claims 10, 19, 29, & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo in view of Nakano (US Patent Application Publication 2004/0145770).

Regarding claim 10, Okubo discloses everything claimed as applied above in claim 1. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30. However, Okubo fails to describe archival of the image file. In addition, the examiner maintains that it was well known in the art to provide archival of an image file, as taught by Nakano.

In a similar field of endeavor, Nakano discloses archiving of digital images. In addition, Nakano discloses managing digital images. Further, Nakano discloses copying or moving a digital image to an archive directory on a desktop computer, server, or removable medium, as disclosed in paragraph 25.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing archiving of digital images, as taught by Nakano, for the purpose of allowing better management of digital images, as disclosed in paragraph 4.

Regarding claim 19, claim 19 is rejected under the same reasoning as applied for claim 10. Claim 19 is also rejected under the “a ‘set’ may be a set of 1” rationale used for claim 2.

Regarding claim 29, Okubo discloses everything claimed as applied above (see claim 10). In addition, claim 29 discloses the medium of claim 20, wherein the

instructions for: sending the second digital image for processing include instructions for sending the second digital image to be archived if the first digital image is substantially blank; and sending the first digital image for processing include instructions for sending the first digital image to be archived if the first digital image is not substantially blank. However, this is not patently distinct from the method described in claim 10, thus claim 29 is rejected for the same reasons as stated above in the rejection of claim 10.

Regarding claim 38, Okubo discloses everything claimed as applied above (see claim 19). In addition, claim 38 discloses the medium of claim 30, wherein the instructions for sending the second set of digital images for processing include instructions for sending the second set of digital images to be archived if the first set of digital images is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be archived if the first set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 19, thus claim 38 is rejected for the same reasons as stated above in the rejection of claim 19.

7. Claims 13, 32, & 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo in view of Ono (US Patent 5796496).

Regarding claim 13, Okubo discloses everything claimed as applied above in claim 11. However, Okubo fails to describe reversing an order of a set of images. In addition, the examiner maintains that it was well known in the art to provide reversing an order of a set of images, as taught by Ono.

In a similar field of endeavor, Ono discloses reversing an order of a set of images. In addition, Ono discloses an image-data processing apparatus which automatically selects one of a copying function and a facsimile function based on an orientation of an original. Further, Ono discloses Figure 3b and description of a reversal of order, as disclosed in Figure 3b and column 4, lines 59-67.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing reversing an order of a set of images, as taught by Ono, for the purpose of allowing a recipient of a fax to see the cover letter before a transmission is completed, as disclosed at column 4, lines 59-67.

Regarding claim 32, Okubo and Ono disclose everything claimed as applied above (see claim 13). In addition, claim 32 discloses the medium of claim 30, having further instructions for reversing an order of the second set of digital images if the first set of digital images is substantially blank. However, this is not patently distinct from the method described in claim 13, thus claim 32 is rejected for the same reasons as stated above in the rejection of claim 13.

Regarding claim 44, Okubo and Ono discloses everything as applied above for claims 42 and 13. In addition, claim 44 is rejected under similar reasoning as applied for claim 13. Claim 44 is also rejected under the "a 'set' may be a set of 1" rationale used for claim 2. Specifically, Ono discloses an image-data processing apparatus that performs reordering as described in column 4, lines 59-67, and reads on claimed reorder module.

Pertinent Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese Patent Application Laid-Open No. 6-261168 A and No. 7-129738 A, US Patent 4839740, US Patent 5138674.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Storey whose telephone number is 571-270-3576. The examiner can normally be reached on Monday - Friday (Alternate Fridays off) 7:30-5 EST.

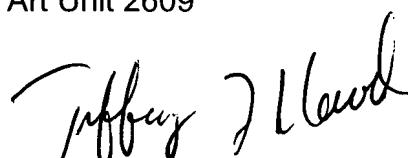
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jefferey F. Harold can be reached on 571-272-7519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William C Storey
Examiner
Art Unit 2609

WCS



JEFFREY F. HAROLD
SUPERVISORY PATENT EXAMINER